

DOCKET NO: 203391US8

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MARI SAITO, ET AL. : EXAMINER: ABEL JALIL, N.
SERIAL NO: 09/785,204 :
FILED: FEBRUARY 20, 2001 : GROUP ART UNIT: 2165
FOR: INFORMATION PROCESSING :
APPARATUS AND METHOD AND
PROGRAM STORAGE MEDIUM

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52 (A)(1)
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Appellants request rehearing of the Decision on Appeal 2008-1232 decided June 18, 2008 by a panel consisting of Judges Dixon, Barry and Thomas. In this request, Appellants assert that the Board misapprehended or overlooked MPEP §§ 1207.05 and 1208, respectively, which were in effect at the time the Reply Brief was filed on August 20, 2007. Appellants additionally assert that the Board misapprehended the motivation given by the Examiner for combining the teachings and suggestions of Shaffer and Conley.

Statement of Facts with respect to misapprehension of MPEP §§ 1207.05 and 1208.

Page 16 of the Decision begins with the heading “A. New Argument in Reply Brief”

The Decision then proceeds to state that:

It is inappropriate for appellants to discuss in their reply brief matters not raised in ... the principal brief[.]. Reply briefs are to be used to reply to matter[s] raised in the brief of the appellee.” *Kaufman Company, Inc. v. Lantech, Inc.*, 807 F.2d 970, 973 n. (Fed. Cir. 1986). “Considering an argument advanced for the first time in a reply brief ... is not only unfair to an appellee ... but also entails

the risk of an improvident or ill-advised opinion on the legal issues tendered.” *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986) (internal citations omitted).

There are cogent reasons for not permitting an appellant to raise issues or arguments in a reply brief. Among them are the unfairness to the appellee who does not have an opportunity to respond and the added burden on the court that a contrary practice would entail. As the Tenth Circuit put it, permitting an appellant to raise new arguments in a reply brief “would be unfair to the court itself, which without the benefit of a response from appellee to an appellant’s late-blooming argument, would run the risk ‘of an improvident or ill-advised opinion, given [the court’s] dependence ... on the adversarial process for sharpening the issues for decision.’” *Headrick [v. Rockwell Intl Corp.]*, 24 F.3d [1272,] 1278 [(10th Cir. 1994)], (quoting *Herbert v. Nat’l Academy of Sciences*, 974 F.2d 192, 196 (D.C. Cir. 1992).

Carbino v. West, 168 F.3d 32, 34-35 (Fed. Cir. 1999).

Here, the Appellants’ Reply Brief includes the following new argument:

“nothing in the suggestion of somehow analyzing an e-mail message or a calendar reminder from 13 teaches ‘selecting an important word from among words contained in said existing text file’ (emphasis added).” (Reply Br. 7.) Because the treatment of the limitation in the Examiner’s Answer (p. 9) is identical to that in the Non-Final Rejection (p. 9) from which the instant appeal was taken, we find nothing that would have prompted the argument. The Appellants could have made the argument in the Second Supplemental Appeal Brief.

The term “reply brief” is exactly that, a brief in reply to new rejections or new arguments set forth in an examiner’s answer. The Appellants may not present their arguments in a piecemeal fashion, holding back arguments until an examiner answers their original brief. Of course, the Appellants may present new arguments directly to the Examiner for consideration as part of a continuing application.

Ex parte Howard, No. 2007-3624, 2008 WL 1997939 (BPAI 2008).

Therefore, we will not consider the new argument. (underlining added).

Thus, the Decision of the Board takes the position that new arguments presented in the Reply Brief that could have been made earlier will not be considered by the Board in rendering their Decision on Appeal.

MPEP Sections 1207.05 and 1208.

MPEP Eighth Ed., Rev. 5, Aug. 2006, § 1207.05, which was in effect when the Reply Brief was filed, states, *inter alia*, that

SUPPLEMENTAL EXAMINER'S ANSWER RESPONDING
TO A REPLY BRIEF

In response to a reply brief filed in compliance with 37 CFR 41.41, the primary examiner may: (A) withdraw the final rejection and reopen prosecution (see MPEP § 1207.04); **or (B) provide a supplemental examiner's answer responding to any new issue raised in the reply brief.** (emphasis added)

In addition, MPEP § 1208 recites, *inter alia*, that in response to a reply brief, the examiner may **"Furnish a supplemental examiner's answer responding to any new issue raised in the reply brief"** (see MPEP § 1207.05). (emphasis added)

Discussion re misapprehension of MPEP §§1207.05 & 1208.

From the above portions of the MPEP, it is clear that PTO policy, as it existed when the Reply Brief was filed, allowed Appellants to present new arguments in the reply brief because the Examiner had the right to enter a supplemental examiner's answer. Accordingly, Appellants believe that the Decision on Appeal, refusing to consider new arguments of Appellant, was in error, as Appellants had the right to present new arguments in the reply brief. Appellants are cognizant of the fact that the newly published final rules for *ex parte* appeals, which were published one week before the Decision on Appeal was rendered, appears to take away Appellants right to present new issues in a reply brief. However, these new rules do not go into effect until December 10, 2008.

Relief Requested with respect to misapprehension of MPEP §§1207.05 and 1208

Appellants request that the new arguments presented in the August 20, 2007 Reply brief, that were not considered by the Board, be considered by the Board, and that the rejection of Claims 7 and 8 be reversed.

Statement of Facts with respect to misapprehension of the motivation provided in the rejection of claims 5-8, 12, 13 and 20.

With respect to Claims 12 and 13, the Decision (page 15) takes the position that “the Examiner specifically explains why it would have been obvious at the time of the invention to a person of ordinary skill in the art to have combined the teachings of Shaffer and Conley to arrive at the claimed subject matter.” The Decision goes on to quote the finding and conclusion of the Examiner (pages 14 and 15). The Decision (page 15) refers to Appellants argument as a “general allegation” and asserts that “[w]ithout specifically addressing the Examiner’s finding or conclusion, the Appellants’ response amounts to a general allegation that the claims define a patentable invention. It shows no error in the Examiner’s reason for combining teachings of Shaffer and Conley. Therefore, we affirm the rejection of claims 12 and 13.” The “general allegation” of Appellant, as quoted in the Decision (page 15) is that the Examiner’s Answer errs in failing to set forth any reasonable basis to even select Conley for combination with Shaffer, much less a reasonable basis to attempt to combine the clearly disparate teachings of these references.

Discussion of the misapprehension of the motivation provided in the rejection of claims 5-8, 12, 13 and 20.

From the above statement of facts, it is clear that the Board considered Appellants argument regarding lack of motivation to be a general allegation, insufficient to overcome the prima facie case of obviousness articulated by the Examiner in the rejection.

However, review of the “motivation” provided by the Examiner, as quoted in the Decision (pages 14 and 15) reveals that the Examiner’s alleged reasoning for combining the references is simply a statement of the benefits that would occur if the teachings of the references were combined. Appellants submit that the mere statement of benefits obtained from combining the teachings of references fails to articulate any reasoning as to why an artisan would have been motivated to combine the teachings and suggestions of the prior art.

Without the articulation of any reasons as to why an artisan would have been motivated to

combine the teachings and suggestions of the prior art, Appellants submit that no prima facie case of obviousness has been properly established. If no prima facie case of obviousness has been established, the rejection under 35 U.S.C. § 103(a) cannot be sustained. Accordingly, the assertion in the brief, as quoted in the decision (page 15) that no reasonable basis has been set forth to select Conley for combination with Shaffer, in view of the disparate teachings of these references is a correct statement, and sufficient to point out the lack of any articulated reasoning for combining the Shaffer and Conley references, as is necessary for the establishment of a prima facie case of obviousness. Accordingly, Appellants believe that the Board overlooked or misapprehended the fact that the alleged motivation provided in the rejection was merely a statement of the benefits that would result from the combination and not an articulated reason as to why an artisan would have been motivated to have combined the teachings and suggestions of Shaffer and Conley. The same argument applies to the other claims so rejected.

Relief Requested Regarding misapprehension of the motivation provided in the rejection of claims 5-8, 12, 13 and 20.

Appellants request that the rejection of these claims be reversed for lack of sufficient motivation to establish a prima facie case of obviousness.


Respectfully submitted,

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